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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,122	03/27/2001	Timothy Jerry Schimke	ROC920000254US1	9560

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EXAMINER

CASIANO, ANGEL L

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/819,122	Applicant(s) SCHIMKE ET AL.	
	Examiner Angel L. Casiano	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

The present Office action is in response to Amendment dated 06 December 2004.

Claims 1-34 are pending in the application. All claims have been examined.

Drawings

1. Previous Objections to the Drawings have been overcome with the present Amendment.

Specification

2. Previous Objection to the Specification has been overcome with the present Amendment.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori [US 6,678,839 B2] in view of Odenwald [US 6,671,727 B1].

Regarding claim 1, Mori teaches a method (see Title) for accurately determining a device location (see column 2, lines 10-11) in an arbitrated loop (see column 1, line 15) having devices,

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where each of the devices has a port bypass circuit (see Abstract; “plural devices 200” and “port bypass circuit 210”). The port bypass circuits are enabled and the arbitrated loop is initialized (see column 3, line 64). An *initial* logical address is set (see column 3, line 56). The cited art cites disabling a port bypass circuit associated with a selected device and identifying a physical location (see column 2, lines 1-7). The initial logical address is stored and the port bypass circuit associated with the selected device is enabled (see column 3, lines 50-60). The process is repeated for the devices (see column 4, lines 14-15; Abstract; column 9, lines 56-57). Nonetheless, the cited reference does not teach a “unique identifier” and “physical slot location” being “mapped”, as claimed. Regarding this limitation, Odenwald explicitly teaches a permanent “unique identifier” (see column 1, lines 39-47). Furthermore, the Odenwald reference discloses “mapping” (see column 2, line 14) for “unique identifiers” and “physical address identifiers”. Accordingly, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to maintain constant device identification regardless of what happens in the loop, in terms of physical location of the devices (see Odenwald, column 2, lines 8-28). This is presented by the Odenwald references as “persistent target identification”.

As for claim 2, Mori teaches determining a set of valid addresses for the devices (see column 3, line 59).

As for claim 3, Mori teaches an *initial address* (see column 3, line 56) that does not correspond to the set of valid physical addresses (for the rest of the devices). Nonetheless, it does not teach an *initiator*. Regarding this limitation, Odenwald teaches an initiator (see column

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2, line 23; Figure 1, “100”). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to implement a method that would maintain target identification in a Fibre Channel environment (see Odenwald).

As per claim 4, Mori teaches disabling a port bypass circuit associated with a selected device (see “bypass”) and determining a logical address for the device (see column 3, line 59-61; Figure 1, “200”).

As for claims 5 and 6, Mori does not teach the step of comparing the logical addresses with the physical slot location of the selected device. Furthermore, the reference fails to teach reporting a *fault condition* in response to these not being identical. Regarding this limitation, Odenwald teaches a method for maintaining constant mapping (see column 2, line 14) in order to avoid a fault condition. Moreover, Odenwald mentions the condition where the logical address and physical locations are not identical (see column 2, lines 2-13). Accordingly, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to maintain constant device identification regardless of what happens in the loop, in terms of physical location of the devices.

As for claim 7, Mori teaches disabling a port bypass circuit associated with a selected device (see “bypass”) and determining a logical address for the device (see column 3, line 59-61; Figure 1, “200”).

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As per claim 8, Mori explicitly teaches an arbitrated loop as Fibre channel arbitrated loop (FC-AL) (see column 1, line 15).

As per claim 9, Mori does not teach a “unique identifier” as a “world wide unique address, WWID”, as claimed. Nonetheless, Odenwald explicitly teaches a world wide unique identifier, according to the FC (Fibre channel) standard (see column 1, lines 39-46). At the time of the invention, one of ordinary skill in the art would have been motivated to combine the disclosures in order to implement a reliable method for target device identification (as presented by Odenwald).

As per claim 10, Mori does not teach a “unique identifier” and “physical slot location” as saved “utilizing a first table”, as claimed. Regarding this limitation, Odenwald teaches a table where physical location as well as unique identifiers are saved (see Figure 4(a)).

As for claim 11, Mori cites disabling a port bypass circuit associated with a selected device and identifying a physical location (see column 2, lines 1-7). However, Mori does not teach storing unique identifiers in a second table. Regarding this aspect of the claim, Odenwald teaches storing “unique identifiers” in a table (see Figure 4(b)), as well as “other methods of forming the associations” (see column 5, lines 1-15). At the time the invention was made, one of ordinary skill in the art would have been motivated to combine the cited disclosures in order to maintain constant device identification regardless of what happens in the loop, in terms of physical location of the devices (see Odenwald, column 2, lines 8-28).

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As for claim 12, Mori does not teach *mapping* “unique identifiers” to obtain a “physical slot location”. However, Odenwald explicitly teaches, “mapping” in order to provide persistent target identification (see column 2, lines 47-53). This mapping allows the method to obtain a physical slot location (see column 2, lines 32-36).

Regarding claim 13, this is oriented to the *computer program product* for implementing the steps (a)-(f) as presented in method claim 1. The combination of references presented in the present Office action teaches or suggests all the limitations corresponding to the method. Therefore, the combination of disclosures also teaches or suggests the limitations corresponding to the computer product for implementing the method. Claims 14-23 contain limitations for the computer program product, which correspond to method claims 2-12. These claims are rejected under the same rationale.

Regarding claim 24, this is oriented to the *arbitrated loop network* implementing the steps (a)-(f) as presented in method claim 1. The combination of references presented in the present Office action teaches or suggests all the limitations corresponding to the method. Therefore, the combination of disclosures also teaches or suggests the limitations corresponding to the loop network system implementing the method.

Dependent claims 25-34 contain limitations for the arbitrated loop system, which correspond to method claims 2-12. These claims are rejected under the same rationale.

Response to Arguments

5. The declaration filed on 06 December 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mori reference [US 6,678,839 B2].

6. Based on the evidence supplied, it appears that applicant is relying on conception prior to the effective date of the reference, followed by diligence until the US filing date.

7. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Mori reference. While conception is the mental part of the inventive art, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Per MPEP 715,

The essential thing to be shown under 37 CFR 1.131 is priority of invention and this may be done by any satisfactory evidence of the fact. **FACTS, not conclusions, must be alleged.** Evidence in the form of exhibits may accompany the affidavit or declaration. **Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show.** For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(A) attached sketches; (B) attached blueprints; (C) attached photographs; (D) attached reproductions of notebook entries; (E) an accompanying model; (F) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989); (G) testimony given in an interference. Where interference testimony is used, the applicant must point out which parts of

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the testimony are being relied on; examiners cannot be expected to search the entire interference record for the evidence. *Ex parte Homan*, 1905 C.D. 288 (Comm'r Pat. 1905); (H) Disclosure documents (MPEP § 1706) may be used as documentary evidence of conception (emphasis added).

A general allegation that the invention was completed prior to the date of the reference is not sufficient. *Ex parte Saunders*, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.13.

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to **show completion of his or her invention prior to the particular date**. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice “amounts essentially to mere pleading, unsupported by proof or a showing of facts” and, thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). **Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant.** 505 F.2d at 718-19, 184 USPQ at 33. See also *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit “asserts that facts exist but does not tell what they are or when they occurred.”) (emphasis added).

In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose.

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8. The declaration and the accompanying exhibit do not provide enough evidence to support all the claimed limitations prior to the reference date, therefore does not support conception of the claimed invention. For example, there is no explanation of the exhibit to support the limitation “A hub having plurality of bypass circuits, having means for enabling, disabling, and saving and repeating these three steps for each of the devices” (claim 24). Applicant did not give a clear explanation pointing out exactly what facts are established and relied upon from the exhibit with respect to this particular limitation. It is to be understood that there are no other claimed limitations that are not sufficiently supported by the evidence provided by the declaration and the accompanying exhibit.

9. Per MPEP 715.07(a)

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958).

However, in the interest of compact prosecution, the Examiner notes that the evidence submitted is insufficient to establish diligence from a date prior to the effective date of the Mori reference (February 1st, 2000) to the US filing date of this application (March 27th, 2001) because Applicant merely alleged that the Applicant or patent owner had been diligent without being specific as to dates and facts. Applicant merely stated that Applicant has been diligent from prior to February 1st, 2000 to at least March 27th, 2001 without providing an account of activities occurring between these dates. “Applicants were diligent in that the Invention Disclosure was submitted to the Intellectual Property Law Department of International Business Machines

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Corporation and was processed as required by corporate policies” represents only a general statement and does not constitute an account of affirmative facts or acceptable excuses occurring between the period of interest (February 1st, 2000 to March 27th, 2001).

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm’r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

Per MPEP 2138.06,

The entire period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). The period during which diligence is required must be accounted for by

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either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field).

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

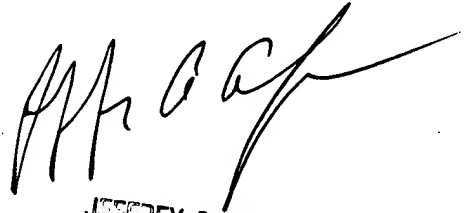
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L Casiano whose telephone number is 571-272-4142. The examiner can normally be reached on 9:00-5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alc
18 February 2005



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
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